

## REMARKS

### INTRODUCTION

In accordance with the foregoing, claims 1, 3, and 6 have been amended. Claim 2 has been cancelled. Claims 6-21 and 30-34 are withdrawn from consideration. Claims 1, 3-5, 22-26, and 28-29 are pending and under consideration.

### REJECTION UNDER 35 U.S.C. §112

Claim 4 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter of the invention.

On page 3, the Office Action states: "Regarding claim 4, the plurality of teeth are described as either having a triangular, rectangular, or trapezoidal shape. Which of the three is claimed? Only one embodiment may be chosen."

Alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 § U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): "made entirely or in part of"; "at least one piece"; and "iron, steel or any other magnetic material." See MPEP 2173.05(h).

In claim 4, the teeth are formed on a respective gear and switch the power to be transmitted to the driving motor.

Withdrawal of the rejection is respectfully requested.

### REJECTIONS UNDER 35 U.S.C. §102

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,904,591 (Shiau). The Office Action asserts that Shiau discloses an alleged driving motor 4; an alleged scanner driving part 2; an alleged printer driving part 2; and an alleged power switching part 5 disposed with the driving motor.

Shiau is directed to a power supply unit 4 of a computer, not to a motor. Shiau does not disclose a scanner driving part. The alleged scanner driving part of Shiau is a power socket. Further, Shiau does not use the term "scanner driving part," at all, and it accordingly follows that Shiau does not disclose "a driving apparatus of a multi-function machine, which includes a scanner unit scanning data recorded on a sheet of document." Shiau does not disclose a printer driving part. The alleged printer driving part of Shiau is a power socket, not a printer driving part.

Withdrawal of the rejection is respectfully requested.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,291,339 (Ogawa).

Ogawa discusses a facsimile transreceiver (abstract).

Ogawa fails to disclose, "a first clutch" and "a first actuating lever" as recited in amended, independent claim 1.

Withdrawal of the rejection is respectfully requested.

Claims 1, 2, and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,854,696 (Yun).

Yun discusses a single motor driving device usable in a facsimile system (abstract). Yun does not disclose a scanner driving part. The alleged scanner driving part 89 of Yun is a transmission roller gear (col. 5, line 31). Further, Yun does not use the term "scanner driving part," at all, and it accordingly follows that Yun does not disclose "a driving apparatus of a multi-function machine, which includes a scanner unit scanning data recorded on a sheet of document."

Yun also fails to disclose "...a first clutch disposed with the driving motor, the scanner driving part, and the printer driving part to move between a first power transmitting position transmitting the power of the driving motor to the scanner driving part and a second power transmitting position transmitting the power of the driving motor to the printer driving part, and a first actuating lever disposed on a moving path of a carrier and actuated by the carrier to move the first clutch between the first power transmitting position and the second power transmitting position" as recited in independent, claim 1.

The alleged first clutch 83 of Yun is not a clutch, but a "push lever" (col. 6, lines 19-20). The push lever 38 of Yun does not transmit the power of the driving motor to the printer driving part. The solenoid 84 is driven to drive the push lever 83 to push toward the first link 82 so that the first gear may be engaged with the first reciprocating gear 94 (col. 5, lines 16-21). Thus, Yun does not disclose "...a first clutch disposed with the driving motor, the scanner driving part, and the printer driving part to move between a first power transmitting position transmitting the power of the driving motor to the scanner driving part and a second power transmitting position transmitting the power of the driving motor to the printer driving part."

Furthermore, Yun simply fails to disclose, "...a first actuating lever disposed on a moving path of a carrier."

Withdrawal of the rejection is respectfully requested.

Claims 24 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,967,239 (Sakakura).

Sakakura fails to disclose "...elastic members disposed between the idle gears and the swing lever to contact the idle gears closely to the swing lever, wherein the elastic members have continuous contact with the idle gears."

The Office Action asserts that pins on the alleged idle gears 285a and 285b are "elastic members." Sakakura discusses the alleged idle gears 285a and 285b being intermeshed with the gear 290. Thus, the gears of Sakakura are interlocked to secure the gears. As shown in Fig. 19 of Sakakura, Sakakura does not have elastic members on the alleged idle gears 285a and 285b.

Thus, Sakakura does not disclose "...elastic members disposed between the idle gears and the swing lever to contact the idle gears closely to the swing lever, wherein the elastic members have continuous contact with the idle gears."

Withdrawal of the rejection is respectfully requested.

Claims 24 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,419,543 (Nakamura).

Nakamura fails to disclose "...elastic members disposed between the idle gears and the swing lever to contact the idle gears closely to the swing lever, wherein the elastic members have continuous contact with the idle gears."

Nakamura describes the use of cam bearings 2 to rotatably support the cam shaft 17 (col. 9, lines 44-46). As shown in Fig. 9, the cam bearings 2 are not disposed between the alleged idle gears 64e, 64f and the swing lever. The alleged elastic member 2 contacts the cam shaft 17 coupling the cam members 14a and 14b (col. 9, lines 24-31). Further, Nakamura does not disclose that the cam bearings 2 are elastic.

Thus, Nakamura fails to disclose "...elastic members disposed between the idle gears and the swing lever to contact the idle gears closely to the swing lever, wherein the elastic members have continuous contact with the idle gears."

Withdrawal of the rejection is respectfully requested.

Claim 29 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,770,555 (Deschamps).

Deschamps fails to disclose "...a main clutch gear movably disposed at a rotation axis and coupled to the driving source to be rotated on the rotation axis."

Deschamps shows a gear wheel 17 mounted on the axle 12 and is in rotation with the pulley 16 (col. 3, lines 65-66; Fig. 2). The device 6 of Deschamps is provided with an arm 11, projecting partially outside, which at its inner end (right-hand end in FIG. 2), is mounted to pivot on an axle 12 (col. 3, lines 55-58). The gear wheel 17 is separately mounted on the arm 11 and not coupled to the alleged driving source 3. Therefore, only the arm 11 of Deschamps is coupled to the alleged driving source 3.

Thus, Deschamps fails to disclose "...a main clutch gear movably disposed at a rotation axis and coupled to the driving source to be rotated on the rotation axis."

Withdrawal of the rejection is respectfully requested.

#### REJECTION UNDER 35 U.S.C. §103

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Yun in view of Sakakura.

On page 6, the Office Action asserts that Sakakura makes up for the deficiencies of Yun. Sakakura does not disclose, *inter alia*, "...a driving apparatus of a multi-function machine, which includes a scanner unit and a printer unit, the driving apparatus comprising: a driving motor; a scanner driving part driving the scanner unit" as recited in amended, independent claim 1 and is not relied upon by the Examiner to do so.

The Office Action states on page 7, line 1 that "Sakakura teaches a second frame (32; fig. 7)."

Sakakura states in col. 5, lines 65-68:

As illustrated in Figs. 7, 8, and 10, in the lower cover unit 32 are secured a process cartridge 52, and LED array 53, and a reversible motor 54, which is a drive source for the rotating elements of the printer.

Therefore, Sakakura does not teach or suggest "the scanner driving part mounted on the second frame" as recited in claim 23.

Additionally the rejection rationale presented is improper. The rejection rationale presented in the outstanding Office Action has set forth the rationale that "at the time of [the] invention, it would have been obvious to one having ordinary skill in the art to employ a second frame, wherein the swing gear train comprises a swing gear disposed at the first frame to

engage with the power switching part mounted on the first frame, a swing lever formed of a V-shaped form, or a pair of idle gears respectively disposed at both ends of the swing lever, as taught by Sakakura, in the device of Yun, for the purpose of providing a device that rotates the output gear in a single direction regardless of the rotation direction of the drive gear." See pg. 7 of the Office Action.

In contrast, Sakakura states in col. 1, line 64 – col. 2, line 1:

These and other objects of the present invention can be achieved by a single motor driving device usable in a facsimile system that may be implemented with a motor rotatable in **one of a first direction and a second direction** (*emphasis added*).

Thus, the Office Action is setting forth a motivational rationale not supported by the record, but rather based solely on the Examiner's belief of what one skilled in the art may have tried or recognized.

However, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper."

The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references

and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of **"common knowledge" and "common sense"** may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Contrary to these requirements, the outstanding Office Action merely presents the proposal that the modification of Yun to include the claimed second frame, which the Office Action has interpreted as being disclosed in Sakakura, and concludes the obviousness of the same, without providing support in the record for motivation of the same.

Such motivational conclusions are improper. The relied upon motivation must be evidenced in the record, and cannot be based merely on an opinion of the Examiner.

Accordingly, it is respectfully requested that the next Office Action following the above guidelines and present a new non-final Office Action, if necessary, presenting rejections based on the same.

Withdrawal of the rejection is respectfully requested.

#### ALLOWABLE SUBJECT MATTER

Claims 3, 5, 26, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 4 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112 and the objection of claim 3.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

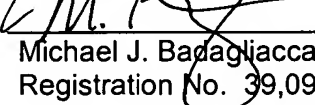
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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